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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MICHAEL BRINKMAN and KIRK LEWIS

Appeal 2009-000612
Application 10/743,215
Technology Center 3600

Decided:¹ June 1, 2009

Before: WILLIAM F. PATE, III, JENNIFER D. BAHR and
STEVEN D.A. MCCARTHY, *Administrative Patent Judges*.

PATE, III, *Administrative Patent Judge*.

DECISION ON APPEAL

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, begins to run from the decided date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or Notification Date (electronic delivery).

STATEMENT OF CASE

Appellants appeal under 35 U.S.C. § 134 from a rejection of claims 1-16. App. Br. 3. We have jurisdiction under 35 U.S.C. § 6(b). The claims are directed to a label holder and a label holder mounted on a C-channel shelf.

Claim 1 is illustrative of the claimed subject matter and is reproduced below:

1. A label holder for attachment to a shelf, the label holder comprising:

a front panel;

a back panel connected to the front panel along a bottom portion thereof, said front panel and said back panel forming a cavity therebetween;

a top flange proximate a top portion of the back panel; and

a shelf clip portion joined to the top flange and spaced rearward of the back panel, said shelf clip portion comprising an upward retaining flange for engaging the shelf and a downward angled portion terminating in a catch flange and a curved resilient hinge portion extended from the downward angled portion and wrapping around the catch flange to form an upward flange.

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

Nagel	US 6,708,436 B2	Mar. 23, 2004
Fast	US 6,688,567 B2	Feb. 10, 2004

The Examiner rejected claims 1-16 under 35 U.S.C. § 103(a) as being unpatentable over Fast in view of Nagel. Ans. 3

ISSUE

Appellants contend that the above rejection is in error because it is unreasonable to read the cover member 18 of Fast as the “back panel” recited in independent claims 1 and 11. App. App. Br. 4-5; Reply Br. 6-7. Thus, we must determine whether Appellant has established that it was unreasonable for the Examiner to read the cover member 18 of Fast as the claimed “back panel.”

Appellants allege that there is no teaching or suggesting to combine Fast and Nagel and that Fast is not properly combinable with Nagel. App. Br. 6-8. Appellants advance this argument without pointing to any specific claim. Claim 1 is selected as the representative claim. 37 C.F.R. § 41.37(c)(1)(vii). Thus, we must also determine whether Appellants have established that the subject matter of claim 1 would not have been obvious because there is no teaching or suggestion to combine Fast and Nagel or because Fast and Nagel are not properly combinable.

Appellants allege that it would not be obvious to make member 18 of Fast, read as the claimed “back panel,” opaque, as recited in claim 8, because doing so would destroy an essential function of Fast. App. Br. 8-9. Thus, we must also determine whether Appellant has established that the Examiner erred by concluding that it would have been obvious to make member 18 of Fast opaque.

Appellants allege that the combination of Fast and Nagel fail to teach the limitation of an upward retaining flange engaging the top support flange of the shelf as required by claim 11. Thus, we must also determine whether Appellants have established that the Examiner erred by concluding that the combination of Fast and Nagel would render obvious the label holder mounted on the C-channel shelf, wherein the label holder has a shelf clip portion having an upward retaining flange engaging the top support flange of the shelf as recited in claim 11.

FINDINGS OF FACT

1. As required by claim 1, the embodiment depicted in figure 10² of Fast discloses a label holder 10 for attachment to a shelf (col. 1, ll. 13-14), the label holder 10 comprising: front lip members 50, 52 (“a front panel”); cover member 18 (“a back panel”) connected to the lip members 50,52 along a bottom portion thereof (proximate reference numeral 20 in Fig. 3), the lip members 50,52 and said cover member 18 forming a cavity 54, 56 therebetween (col. 5, ll. 10-20); a top flange (above pocket 54 as viewed in Fig. 3) proximate a top portion of the cover member 18; and body panel 16 and tail 115 (“a shelf clip portion”) joined to the top flange (via 18, 20) and spaced rearward of the back panel (leftward as viewed in Fig. 10), the body panel 16 and tail 115 comprising an upward retaining flange 32 for engaging the shelf (See e.g., Fig. 12) and a downward angled portion (proximate reference numeral 115 in fig. 10) terminating in a finger 122 (“a catch flange”) and rearwardly extending flange 38e

² We adopt the Examiner’s convention of referring to like parts of Figures 3 and 10 by reference to the numerals depicted in Figure 3.

and arcuate rear portion 120 (“a curved resilient hinge portion”; col. 8, ll. 25-31; Fig. 12) extended from the downward angled portion and wrapping around the catch flange to form an upward flange (at the end of 120).

2. A primary purpose of the label holder portion (between body panel 16 and cover panel 18) of Fast is to display consumer information. Col. 1, ll. 13-19.
3. Fast additionally discloses that although the disclosed designs are particularly adapted to secure a label/sign holder to a shelf devoid of a C-channel, similar elements could be used even if the shelf included a C-channel. Col. 9, ll. 5-13. Fast does not provide any specific details of how the disclosed designs should be modified to accomplish this.
4. Nagel describes a label display strip 10 (col. 3, l. 44) but discloses that the specific details of the connection between the label display strip 10 and the shelf do not form part of the disclosed invention (col. 3, l. 65 - col. 4, l. 5). Those details are not further discussed in Nagel.

PRINCIPLES OF LAW

Where no explicit definition for a term is given in the specification, the term should be given its ordinary meaning and broadest reasonable interpretation. *E-Pass Technologies, Inc. v. 3Com Corporation*, 343 F.3d 1364, 1368 (Fed. Cir. 2003). The ordinary and customary meaning of a claim term is the meaning that the term would have to a person of ordinary skill in the art in question at the time of the invention. *Phillips v. AWH Corp.*, 415 F.3d 1303, 1319 (Fed. Cir. 2005) (en banc). An applicant is entitled to be his or her own lexicographer and may rebut the presumption

that claim terms are to be given their ordinary and customary meaning by clearly setting forth a definition of the term that is different from its ordinary and customary meaning(s). *See In re Paulsen*, 30 F.3d 1475, 1480 (Fed. Cir. 1994).

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987). These elements must be arranged as in the claim under review but this is not an *ipsissimis verbis* test. *In re Bond* 910 F.2d 831, 832 (Fed. Cir. 1990). Anticipation is a question of fact, *In re Baxter Travenol Labs.* 952 F.2d 388, 390 (Fed. Cir. 1991), and is the ultimate of obviousness, *id.* at 391.

A prior art reference in effect teaches away from those modifications that would render it inoperable for its intended purpose, thereby making it improper to base an obviousness rejection on proposed modification that would render the prior art invention being modified unsatisfactory for its intended purpose. *See In re Gordon*, 733 F.2d 900.

The examiner bears the initial burden of factually supporting any prima facie conclusion of obviousness. The key to supporting any prima facie conclusion of obviousness under 35 U.S.C. § 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. The Court in *KSR International Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (2007) noted that the analysis supporting a rejection under 35 U.S.C. § 103 should be made explicit. The Federal Circuit has stated that “rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some

rational underpinning to support the legal conclusion of obviousness.” *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006), cited with approval in *KSR*, 550 U.S. at 418.

ANALYSIS

Fast discloses each and every element of claim 1 and therefore anticipates claim 1. Fact 1. Appellants do not point to any express or implied structure of the claimed “back panel” that would preclude the cover member 18 from being reasonably read as the claimed back panel. The particular nomenclature chosen by Fast is not dispositive of whether the cover member 18 may be reasonably read as the claimed “back panel.” *Contra* App. Br.4-6; Reply Br.6-7. While cover member 18 may be forward of the body panel 16 and label contained in pocket 17 (col. 5, ll. 50-55), cover member 18 is rearward of the lip members 50, 52 and cavities 54, 56 holding a sign formed thereby and therefore may reasonably be considered the claimed “back panel.”

Since the cover member of Fast, read as the claimed “back panel,” is connected to the lips 50,52, read as the claimed “front panel,” along a bottom portion thereof (i.e., at 52) and forms a cavity 54, 56 therebetween, it is not necessary to rely upon the teachings of Nagel to meet this limitation. Since Fast anticipates claim 1 and since anticipation is the epitome of obviousness, the teachings of Nagel need not be relied upon to establish that the subject matter of claim 1 would have been obvious to one having ordinary skill in the art. Thus, Appellants’ arguments that the claims are non-obvious because there is no teaching or suggestion to combine Fast and

Nagel or because Fast and Nagel are not properly combinable (App. Br. 6-8) are not persuasive.

A primary purpose of Fast is to display consumer information. Fact 2. Making panel 18 opaque would defeat that purpose (App. Br. 8-9) and therefore would not be obvious as the Examiner suggests (Ans. 4, 6-7). While Fast discloses that the material itself is not critical (*see* Ans. 7) it is critical that whatever material is employed to construct the cover panel 18 be transparent because making it opaque would make it impossible to view the label.

While Fast suggests the disclosed designs may be modified for use with a C-channel, Fast does not provide details of how this is achieved. Fact 3. Claim 11 requires more than just the capability of use with a C-channel as the Examiner suggests (*see* Ans. 4-5; 7). Claim 11 requires specific structural relationships between the claimed label holder and the claimed C-channel shelf. Claim 11 is therefore directed not to just a label holder that is intended to be used with a C-channel shelf but to the combination of a label holder and a C-channel shelf. Neither Fast nor Nagel teaches or discloses any specific structural relationship between the label holder and C-channel shelf. Facts 3 and 4. Therefore neither Fast nor Nagel explicitly teaches or discloses a label holder mounted on a C-channel shelf wherein the label holder comprises a shelf clip portion having an upward retaining flange engaging the top support flange of the shelf as required by claim 11. App. Br. 9-10. Since Fast and Nagel do not teach or disclose this claimed structure and the Examiner does not articulate any reason why it would have been obvious to provide it in light of the teachings of Fast and Nagel, we must

conclude that the Examiner erred by rejecting claim 11 as being unpatentable over Fast in view of Nagel.

CONCLUSION OF LAW

On the record before us, Appellant has not established that it was unreasonable for the Examiner to read the cover member 18 of Fast as the claimed “back panel;” that the subject matter of claim 1 would not have been obvious because there is no teaching or suggestion to combine Fast and Nagel; or that the subject matter of claim 1 would not have been obvious because Fast and Nagel are not properly combinable. Appellant has established that the Examiner erred by concluding that it would have been obvious to make member 18 of Fast opaque. Appellant has also established that the Examiner erred by concluding that the combination of Fast and Nagel would render obvious the label holder mounted on the C-channel shelf, wherein the label holder has a shelf clip portion having an upward retaining flange engaging the top support flange of the shelf as recited in claim 11.

DECISION

For the above reasons, the Examiner's rejection of claims 1-7, 9 and 10 is affirmed and the Examiner's rejection of claims 8 and 11-16 is reversed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). See 37 C.F.R. § 1.136(a)(1)(iv) (2007).

AFFIRMED-IN-PART

Appeal 2009-000612
Application 10/743,215

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vsh